

REMARKS

I. Status and Disposition of the Claims

In the instant application, claims 1-54, of which claims 1, 17 and 33 are independent, are pending and under consideration on the merits.

In the Office Action¹ mailed April 25, 2008, the following actions were taken:

1) claims 1, 17, 33 and 46-54 were rejected under 35 U.S.C. §102(a) as being anticipated by US Pub. No. 2003/0046281, by Son (hereinafter "*Son*");

2) claims 2-16, 18-32 and 34-45 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Son* and further in view of US Pat. No 5,222,234, by Wang (hereinafter "*Wang*").

II. Amendments to the Claims

In this Amendment and Response to the Office Action, Applicant amends claims 1, 5, 11, 14, 17, 21, 27, 30, 33, 37, 43, 46, 47, 49, 50, 52 and 53. Support for amendments to claims 1, 17 and 33 are found at page 7, lines 25-27 of the Specification, "According to some aspects of the invention, the identity and content of one or more resources identified by a search query may be preserved, or set aside, at a specified system location, such as in a folder," and page 10, lines 25-27 of the Specification, "Upon the selection of one or more resources in act 315, a user may preserve the resources in a system- or user- designated system location, such as a

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

folder. (That is, the location is designated before actual preservation occurs)", and page 9, lines 16-20 of the Specification, "A user may save these criteria (e.g., thereby creating an indication of a saved search, which may subsequently be shown in drop-down box 430) by clicking button 460," and page 5, lines 13-15, "Resources may be maintained in the state at which they existed at the time of preservation (i.e., their content may be preserved as it existed as of the time of preservation)."

Support for amendments to claims 5, 21 and 37 are found at page 9, lines 28-32, "In the example shown, search results 511A-511J are provided as HTML hyperlinks to the resources, although any form of identifier which facilitates access to the resources (e.g., a universal resource locator, name or identifier) may be employed. The identifier(s) may provide access to resources stored, for example, in the data structure depicted in FIG. 9, discussed in detail below."

Claims 46, 49 and 52 were amended to correct an obvious antecedent basis issue.

In addition, Applicant has cancelled claims 4, 20 and 36, amended claims 47, 50 and 53, and added claims 55-60. Support for the amendments to claims 47, 50 and 53 and for the newly added claims 55-60 may be found in the Specification at page 5 line 32 - page 6, line 7, "If the resource is physically duplicated, the operation may create a "snap shot" of the resource, thereby preserving the resource in the "state" in which it existed at the time of the operation, while the "original" resource may continue to be accessed and/or modified, if desired. Of course, the resource need not be physically duplicated to be stored in the new location, as an association between a resource and its new location may be implemented logically. For example, a data structure, such as

one or more persistent data stores such as relational database tables, may be updated to provide a logical relationship between the resource and the new location.”

III. Telephone Interview with Examiner

Applicant's representatives thank Examiner Leroux for the courtesies extended in granting and conducting a telephone interview on July 14, 2008. The substance of the interview is summarized herein.

During the interview, Applicant's representatives provided an overview of embodiments of the claimed data access and retrieval mechanism, and identified elements in the claims that they think distinguish the claimed methods, systems and computer-readable media from the cited references. The elements that were discussed are the elements discussed below.

Although no agreement was reached on the claims' language, Examiner Leroux provided clarifications of his rejections and indicated that he understood the arguments presented by Applicant's representatives. Examiner Leroux proposed that limitations be added to the independent claims, and requested that a written response be filed for his consideration.

IV. Response to Rejections

A. The Rejection of the Claims under 35 U.S.C. 102 is improper.

In the Office Action, claims 1, 17, 33 and 46-54 were rejected under 35 U.S.C. §102 as being anticipated by *Son*. To properly establish that a prior art reference anticipates a claimed invention under 102, each and every element of the claims in

issue must be found, whether expressly described or under principles of inherency, in the single prior art reference.

For an Office Action to make out a prima facie case of inherent disclosure, “the missing descriptive matter is necessarily present in the thing described in the reference.” See M.P.E.P. § 2112 (IV), quoting *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). “In relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (Emphasis added) See *id.*, quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

i. Claims 1, 17, 33 and 46-54 are allowable.

Applicant respectfully traverses the rejection of claims 1, 17, 33 and 46-54 since *Son* fails to teach each and every element of these claims. For example, *Son* does not disclose at least the following elements found in amended claim 1:

- “after the user’s selection of the at least one resource from the at least one search result, **designating a system location** in which the content of the selected at least one resource is to be preserved...” (Emphasis added), and
- “executing, in response to the user’s selection, a command to **preserve the content** of the selected at least one resource in the system location.” (Emphasis added)

While the Office Action did not address the first element, namely the “designating” element because it has been newly added to claim 1, the Office Action

cites *Son*'s para. [0059] and Fig. 2 as teaching, "the search criteria, and the search results are stored in the storage 33 as one data set. Search history data records are accumulated in the storage 33." See Office Action page 3. However, neither the search criteria nor search results disclosed by *Son* consist of content. See *Son* at Figs. 2, 9 and 10. Continuing with *Son*'s para. [0059], "A search history record consists of entries such as, for example, those that are shown in Fig. 2. In this example, the entries consist of a user ID (history record registrant name) which is used as the key of the record, contact to the user (registrant) (A), specified search criteria (B), search results (C), time when the search was executed (D) accordingly to the clock 34, evaluation (E), and comments (F)." See *Son* at para. [0059]. Therefore, the search history data as disclosed by *Son* does not comprise **content** of resources identified by the search results. (Emphasis added) While the search history data is stored in storage 33, there is no **content** stored in storage 33. (Emphasis added) Therefore, *Son* does not disclose, teach or suggest, "after the user's selection of the at least one resource from the at least one search results, designating a system location in which the content of the selected at least one resource is to be preserved."

Moreover, *Son* does not disclose, teach or suggest, "executing, in response to the user's selection, a command to **preserve the content** of the selected at least one resource in the system location." The Office Action cites *Son*'s para. [0101] as teaching this element. See Office Action page 3. Applicant respectfully points out that *Son*'s para. [0101] does not refer to preserving the content of the resource in the system location as disclosed in amended claim 1. In *Son*, the user selects content directly from

the search results and issues a request to get the content. See *Son's* para. 0067.

However, *Son* is silent on designating a system location for the content and preserving the content of the selected resource in the system location. The operation of the content retrieval process is explained in more detail in *Son's* para. [0094],

“When the first user selects desired content out of his or her search results presented on the window shown in Fig. 10 and issues a request for retrieval of the content (S7), the intermediate server 3 sends to the central server 1 a request for retrieval of the content on behalf of the user (S8). The central server 1 authenticates the intermediate server 3 and distributes the content to the intermediate server 3 (S9). The intermediate server 3 transfers the retrieved content to the user terminal 2 of the first user (S10) and charges the first user for the content (S11).”

Therefore, in *Son*, the content from the content database in the central server is transferred to the user terminal, but no further steps are disclosed. *Son* does not disclose or suggest preserving the content or selecting a system location in which the resources are to be preserved if preserved at all.

An earlier Office Action contained an assertion that the claimed command to preserve the content of the selected resource is inherent in para. [0101] of *Son*. See Office Action dated November 26, 2007 at 10. However, as stated above, “In relying upon the theory of inherency, the examiner must provide basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” (Emphasis added) See M.P.E.P. § 2112 (IV), quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Applicant respectfully points out that such basis has not been

provided. Certainly, in *Son*, the user can **only** view the content when the content is transferred to the user terminal. When content is transferred to the user terminal, it need not necessarily be preserved. Further, if content is preserved, a system location need not necessarily be designated. Therefore, nowhere in this citation or elsewhere in *Son* is there a suggestion of **preserving the content** of the selected resource **in the system location** nor is there a basis for asserting that such limitations are inherent in *Son*. (Emphasis Added)

Therefore, nowhere in *Son*'s para. 0101 or elsewhere in *Son*, is there a suggestion for "designating a system location in which the content of the selected at least one resource is to be preserved," and "executing, in response to the user's selection, a command to preserve the content of the selected at least one resource in the system location" as recited in amended claim 1.

For at least these reasons, claim 1 is allowable under 35 U.S.C. §102. For at least the reasons stated above with respect to claim 1, claims 17 and 33 are allowable at least since they recite similar elements and were rejected under the same rationale as claim 1. See Office Action at page 2. Moreover, claims 46-54 are allowable since they depend directly or indirectly from claims 1, 17 and 33.

For these reasons, Applicant's claims are patentably distinct from *Son*. Applicant respectfully requests the rejection under 35 U.S.C. §102 of independent claims 1, 17, 33 and claims 46-54 which depend therefrom, to be withdrawn.

B. The Rejection of the Claims under 35 U.S.C. 103(a) is improper.

Applicant respectfully traverses the rejection of claims 2-16, 18-32 and 34-45 under 35 U.S.C. §103(a) as being unpatentable over *Son* in view of *Wang*, because a *prima facie* case of obviousness has not been established. “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

The Supreme Court in *KSR Int’l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007) held that “[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, suggestion, motivation] test and the *Graham* analysis.” M.P.E.P. §2141 (rev. 6, Sept. 2007), citing *KSR* at 82 U.S.P.Q. 2d at 1396. Applicant understands this

to mean that when applicable, as here, TSM reasoning may still be applied not only by an examiner but also by Applicant to refute a §103 rejection.

Here, a *prima facie* case of obviousness has not been established because the scope and content of the prior art has not been properly determined, nor have the differences between the claimed invention and the prior art been properly ascertained. Accordingly, a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art has not been clearly articulated.

i. Claims 2-16, 18-32 and 34-45 are allowable.

Claims 2-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Son* in view of *Wang*. The Office Action contains the assertion, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Son* to include teachings of *Wang*." Applicant respectfully disagrees with the assertion and traverses the rejection for at least the reasons stated below.

Claims 2-16 depend from claim 1, and thus include all the elements and limitations thereof. As set forth above with respect to claim 1, *Son* fails to teach, disclose or suggest the features recited in claim 1, and required by claims 2-16, namely, "designating a system location in which the content of the selected at least one resource is to be preserved," and "executing, in response to the user's selection, a command to preserve the content of the selected at least one resource in the system location." The Office Action cited *Wang*, in combination or alone with *Son*, as teaching features recited in claims 2-16, but not recited in claim 1. See Office Action at page 3-7. Even assuming the Office Action's assertion is correct, *Wang* fails to cure the deficiencies of

Son discussed above. That is, *Wang* also fails to teach, disclose or suggest, “designating a system location in which the content of the selected at least one resource is to be preserved,” and “executing, in response to the user’s selection, a command to preserve the content of the selected at least one resource in the system location,” as recited in amended claim 1 and required in claims 2-16.

Moreover, one of ordinary skill in the art would not find it obvious to modify the apparatus of *Son*, using the teachings of *Wang*, to achieve the required combination recited by amended claim 1. Applicant submits that while examiners may rely upon what is generally known in the art, they **must provide evidentiary proof** of that knowledge. See *In re Zurko*, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001) (“With respect to core factual findings in a determination of patentability . . . the Board cannot simply reach conclusions based on its own understanding or expertise . . . Rather, the Board **must point to some concrete evidence** in the record in support of these findings.”) (emphasis is added).

Here, Applicant respectfully submits that the Office Action has not explained *why* or *how* one of ordinary skill would modify the system of *Son*, using the teachings of *Wang*, so as to arrive at the claimed invention. In particular, the Office Action has not explained at least: (a) *why* one of ordinary skill would modify the steps of *Son* so as to designate a system location and preserve the content in the system location; and, especially, (b) *how* one of ordinary skill would know to select and arrange the steps of *Son* and *Wang* so as to arrive at a system with the claimed features of “designating a system location in which the content of the selected at least one resource is to be preserved,” and “executing, in response to the user’s selection, a command to preserve

the content of the selected at least one resource in the system location," as recited in amended claim 1.

The burden is on the Patent Office to provide some tenable rationale as to *why* one of ordinary skill in the art would combine *Son* and *Wang* so as to arrive at the presently claimed methods recited in claims 2 - 16. In the present case, however, no such rationale has been provided.

For all of the §103 rejections except for that of claim 2, the Office Action merely asserts, "The combination of *Son* and *Wang* discloses the elements of the claimed invention as noted above and, furthermore, discloses [the feature recited in the claim]." None of these assertions demonstrate *why* or *how* one would modify *Son*'s system with *Wang*'s features so as to arrive at the claimed invention.

The only statement about why the combination of *Son* and *Wang* would be obvious appears on page 4 of the Office Action in connection with the rejection of claim 2. The Office Action contains the assertion, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify *Son* to include wherein the system location comprises a folder as taught by *Wang* for the purpose of saving similar content in an easily accessible memory location." See Office Action at 4.

At best, the Office Action's assertion could be considered an assertion that the proposed modifications could be performed. However, "[t]he mere fact that a reference can be combined or modified does not render the resultant combination [or modification] obvious unless the results would have been predictable to one of ordinary skill in the art." M.P.E.P. § 2143.01 (emphasis in original). Combining *Son* and *Wang* would not result in a predictable variation of Applicant's invention because *Son* and *Wang* lack the

elements recited in amended claim 1, namely “designating a system location in which the content of the selected at least one resource is to be preserved,” and “executing, in response to the user’s selection, a command to preserve the content of the selected at least one resource in the system location.”

Further, even assuming *arguendo* that the Office Action’s assertion is correct, “saving similar content in an easily accessible memory location” is not sufficient motivation for including a folder as a system location in *Son*, since nowhere in *Son* is there a suggestion of saving content in a system location. There would be no point to *Son* including a folder as a system location if *Son*’s content is not stored in designated system locations. Therefore, combining *Wang* with *Son* misses the objective of the Applicant’s system as recited in amended claim 1.

For at least these reasons, Applicant submits that the Office has not met the burdens necessary to establish that present claims 2-16 are obvious under § 103(a). Therefore the § 103(a) rejection of claims 2 -16 is improper, and should be withdrawn.

For at least the reasons noted above, claims 18-32 and 34-45, which recite similar elements and were rejected under the same rationale, are allowable under 35 U.S.C. 103(a). See Office Action at page 3-7.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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